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PRE-APPEAL BRIEF REQUEST FOR REVIEWDocket Number (Optional)
9751-1

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Application Number
10/624,227Filed
July 22, 2003on 11/14/07

First Named Inventor

RENDON

Signature *Amy A. Dobbelaere*

Art Unit

Examiner

Typed or printed

1615

CHANNAVAJALA,
LAKSHMI SARADAname Amy A. Dobbelaere, Ph.D.

Applicant requests review of the final rejection in the above-identified application. No Amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

☐ applicant/inventor.

☐ assignee of record of the entire interest.
See 37 CFR 3.71 Statement under 37 CFR 3.73(b) is enclosed.
(Form PTO/SB/96)

☒ attorney or agent of record.
Registration number 52,088
☐ attorney or agent acting under 37 CFR 1.34.
Registration number if acting under 37 CFR 1.34 _____

Signature

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Typed or printed name

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Telephone number

November 14, 2007
Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below.



*Total of forms are submitted.

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

{WP448607;1}

PATENT**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re Application of Marta I. Rendon

Confirmation No. 7807

Application No. 10/624,227

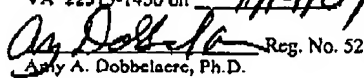
Examiner: Channavajjala, Lakshmi Sarada

Filed: 07/22/2003

Group Art Unit: 1615

For: METHOD & TOPICAL COMPOSITION FOR THE TREATMENT OF
HYPERPIGMENTED SKIN**PRE-APPEAL BRIEF REQUEST FOR REVIEW****CERTIFICATE OF TRANSMISSION/MAILING**

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 Reg. No. 52,088
Amy A. Dobbela, Ph.D.

Mail Stop AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

In response to the final Office Action dated August 16, 2007. Applicant respectfully files herewith a Notice of Appeal and requests review of the present application before filing an appeal brief.

Related Appeals

The issues presented in the present application are not related to any pending appeal.

Status of the Claims

Claims 1-20 are pending in the application. Independent claims 1, 12, and 17 (and dependent claims 2-4 and 13) stand finally rejected under 35 U.S.C. §103(a) as being unpatentable over US patent no. 5,523,090 to Znaiden ("Znaiden") and WO 94/15626. Independent claims 1, 11, 12, and 16-20 (and dependent claims 2-10, and 13-15) stand finally rejected under 35 U.S.C. §103(a) as being unpatentable over Znaiden in view of JP 200351722 and WO 94/15626.

Clear Errors for Review

Applicant respectfully asserts that there is no motivation for combining WO 94/15626 and Znaiden nor for combining Znaiden, JP 200351722, and WO 94/15626 to result in the claimed subject matter of a topical composition including a mixture of vismia and phytic acid, each in an amount effective to lighten skin, because: 1) the elements in the claimed combination do not merely perform the function that each element performs separately, and 2) the results of the claimed combination were unexpected. Furthermore, Applicant submits that Znaiden, WO 94/15626, and JP 200351722, alone or in combination, do not teach all the claim limitations present in independent claims 1 (from which claims 2-10 depend), 11, 12 (from which claims 13-15 depend), and 16-20.

Claim 1 recites a "topical composition comprising a mixture of vismia in an amount effective to lighten skin and phytic acid in an amount effective to lighten skin." Independent claims 12, and 16-20 recite "a topical composition comprising: a. about one to about five percent vismia, wherein about one to about five percent is an amount of vismia effective to lighten skin; and b. about one to about five percent phytic acid, wherein about one to about five percent is an amount of phytic acid effective to lighten skin."

None of Znaiden, WO 94/15626 and JP 200351722 teach the limitation of "phytic acid in an amount effective to lighten skin," nor do any of these references teach the limitation of "vismia in an amount effective to lighten skin," as claimed in the instant application. In contrast, the present application teaches amounts of phytic acid and vismia that are effective to lighten skin. For example, Applicant showed that a composition containing 1-5% vismia as a percent weight of the composition (which also includes phytic acid) resulted in a composition that lightened skin with long-lasting effects and without any toxicity (see Figures 3 and 5). None of the cited references teach vismia at a concentration of 1-5% as a percent weight of a composition. In addition, Applicant actually found a synergistic effect with vismia and phytic acid. Using vismia and phytic in combination resulted in greater effects than using either vismia or phytic acid alone. See paragraphs [0039], [0040], and [0085].

In contrast to the claimed invention, Znaiden teaches using phytic acid for treating cellulite and skin whitening agents such as ferulic acid or kojic acid. WO 94/15626 teaches using vismia for promoting collagen synthesis, while JP 200351722 teaches skin-lightening cosmetics containing kojic acid and arbutin. None of these references teach using phytic acid or vismia for lightening skin, only for promoting collagen synthesis and reducing cellulite, two

(WP443456:1)

functions that have nothing to do with skin lightening. On page 4 of the Office Action, the Examiner states that "[a]ccording to instant claims Vismia and phytic acid are not required to be effective anti-pigmentation agents and therefore, the combination of Znaiden with JP and WO results in a composition effective in melanin inhibition (skin lightening agents) due to kojic acid, arbutin and effective in skin firming due to phytic acid and Vismia." Applicant respectfully disagrees with this assertion, and point to the current claims which indeed require that vismia and phytic acid are effective anti-pigmentation agents (e.g., "vismia in an amount effective to lighten skin and phytic acid in an amount effective to lighten skin"). Furthermore, combining these references does not result in a composition containing vismia and phytic acid in amounts effective to lighten skin. Because not a single one of these references, nor the combination thereof, teaches vismia and phytic acid in amounts effective for lightening skin, the combination of these references fails to teach or even suggest all claim limitations present in the currently pending claims as amended herein.

Prior to the present application, phytic acid had not been described or used as a lightening agent, and its effect on pigmentation or melanogenesis was not previously reported or documented (see paragraph [0030]). Vismia also was not reported or described for use in lightening skin prior to the present application (see paragraph [0052]). Applicant surprisingly found that combining vismia and phytic acid resulted in a safe composition effective for lightening human skin. See paragraphs [0066] and Figures 3 and 5.

Based on the foregoing, Applicant submits that the cited references do not render the present invention obvious within the meaning of 35 U.S.C. 103. Applicant submits that none of the references cited above, nor the combination of, teach all the limitations of the present claims, nor do the references suggest modifying their teachings to arrive at applicant's invention. Applicant further submits that the results of the claimed combination were unexpected, and the elements (i.e., vismia and phytic acid) in combination do not merely perform the function that each element performs separately. The claimed combination shows synergistic effects, providing greater effects than using either vismia or phytic acid alone.

Accordingly, it is respectfully submitted that the claims are in condition for allowance and clear error has been committed in the final Office Action. The Commissioner is hereby authorized to charge any additional fees which may be required at any time during the prosecution of this application, or credit any overpayment, to Deposit Account Number 50-0951.

Date: 11/14/07

Docket No. 9751-1

Respectfully submitted,



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